UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,535	02/01/2001	Hisao Haji	81754.0050	2273

26021	7590	06/17/2005

HOGAN & HARTSON L.L.P.
500 S. GRAND AVENUE
SUITE 1900
LOS ANGELES, CA 90071-2611

EXAMINER
QUELER, ADAM M

ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	09/775,535	HAJI ET AL.
	Examiner	**Art Unit**	
	Adam M Queler	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 May 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: RCE and Amendment filed 05/03/2005.

2.   Claims 1-15 are pending in the case. Claims 1, 3, and 5-15 are independent claims.

Continued Examination Under 37 CFR 1.114

3.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 05/03/2005 has been entered.

Specification

4.   The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

6.   **Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply**

with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-13 generally recite (with varying language), selecting a display control program

based on a condition. However, this not taught by the specification. There are not multiple

display control program's disclosed that could be selected. The conditions are described

generally from the last paragraph of page 16 to page 18. They generally describe optimizing a

web page based on conditions, but never selecting a display control program based on those

conditions. The "display control program" is also never adequately disclosed, and also only

discussed in generalities. As the display control program has a specific function, how would one

know which one to select according to these conditions? As such one of ordinary skill in the art

would have to resort to undue experimentation in order to determine what multiple display

control programs were available and how to select them.

Claims 1, 2, 14, and 15 do recite, "the web page is optimized according to" various

conditions. This is more accurately describes the disclosure on pages 16-18. However, the

actual optimization is never disclosed. There is no teaching of **how** to optimize the page

accordingly, merely vague statements about adjusting data size and a "minimum image data."

These are not given any further treatment. As such, one of ordinary skill in the art would have to

resort to undue experimentation to determine the conditions and optimizations necessary to carry

out the invention.

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

8.   Claims 3-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

As described above, the claims recite selecting a display program, but do not provide any

details as to what it is selected from. Given the disclosure, and the language of claims 1, 14, and

15, this will be interpreted as the more general "optimization" for examining purposes only.

This is further determined from the Applicant's response of 5/3/05, page 9, lines 5-6.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler

et al. (US006725257B1, filed 11/30/1999), and further in view of Uemura et al.

(US006243392B1, filed 5/30/1997).

Regarding independent claim(s) 1, Cansler discloses generating a web page that has a display

control program and data needed (col. 4, ll. 5-13). Cansler discloses selecting the program

according to a request (col. 4, ll. 33-36). Cansler teaches the computations are performed by the

receiving terminal (col. 4, line 17). Cansler teaches transmitting the through a network (col. 5, ll.

7-25).

Cansler does not disclose optimization. Uemura discloses optimizing a web page

according to capability of the receiving terminal (col. 2, ll. 9-13). It would have been obvious to

one of ordinary skill in the art at the time of the invention to optimize Cansler with the teachings

of Uemura in order to statisfy users (Uemura, col. 1, ll. 59-61) and prevent them from leaving the

site (Uemura, col. 11, ll. 30-37).

Regarding dependent claim(s) 2, Cansler teaches the web page making a quotation calculation

on the receiving terminal (col. 4, line 17).

Regarding independent claim(s) 3, Cansler discloses generating a web page that has a display control program and data needed (col. 4, ll. 5-13). Cansler teaches the computations are performed by the receiving terminal (col. 4, line 17). Cansler teaches transmitting the through a network (col. 5, ll. 7-25).

Cansler does not disclose optimization. Uemura discloses optimizing a web page according to capability of the receiving terminal (col. 2, ll. 9-13). It would have been obvious to one of ordinary skill in the art at the time of the invention to optimize Cansler with the teachings of Uemura in order to statisfy users (Uemura, col. 1, ll. 59-61) and prevent them from leaving the site (Uemura, col. 11, ll. 30-37).

Regarding independent claim(s) 4, Cansler does not disclose optimization. Uemura discloses optimizing a web page according to capability of the receiving terminal (col. 2, ll. 9-13), where the user informs the server of the capability (col. 4, ll. 51-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to optimize Cansler with the teachings of Uemura in order to statisfy users (Uemura, col. 1, ll. 59-61) and prevent them from leaving the site (Uemura, col. 11, ll. 30-37).

Regarding independent claim(s) 5, Cansler discloses generating a web page that has a display control program and data needed (col. 4, ll. 5-13). Cansler teaches the computations are performed by the receiving terminal (col. 4, line 17). Cansler teaches transmitting the through a network (col. 5, ll. 7-25).

Cansler does not disclose optimization. Uemura discloses optimizing a web page according to capability of the receiving terminal (col. 2, ll. 9-13), including display format (col. 3, ll. 35-50). . It would have been obvious to one of ordinary skill in the art at the time of the

invention to optimize Cansler with the teachings of Uemura in order to statisfy users (Uemura,

col. 1, ll. 59-61) and prevent them from leaving the site (Uemura, col. 11, ll. 30-37).

Regarding independent claim(s) 6, Cansler discloses generating a web page that has a display

control program and data needed (col. 4, ll. 5-13). Cansler teaches the computations are

performed by the receiving terminal (col. 4, line 17). Cansler teaches transmitting the through a

network (col. 5, ll. 7-25).

Cansler does not disclose optimization. Uemura discloses optimizing a web page

according amount of network traffic (col. 2, ll. 9-13). It would have been obvious to one of

ordinary skill in the art at the time of the invention to optimize Cansler with the teachings of

Uemura in order to statisfy users (Uemura, col. 1, ll. 59-61) and prevent them from leaving the

site (Uemura, col. 11, ll. 30-37).

Regarding independent claim(s) 7, Cansler discloses generating a web page that has a display

control program and data needed (col. 4, ll. 5-13). Cansler teaches the computations are

performed by the receiving terminal (col. 4, line 17). Cansler teaches transmitting the through a

network (col. 5, ll. 7-25).

Cansler does not disclose optimization. Uemura discloses optimizing a web page

according to capability of the network (col. 2, ll. 9-13 and col. 4, ll. 43-45). It would have been

obvious to one of ordinary skill in the art at the time of the invention to optimize Cansler with

the teachings of Uemura in order to statisfy users (Uemura, col. 1, ll. 59-61) and prevent them

from leaving the site (Uemura, col. 11, ll. 30-37).

Regarding independent claim(s) 8, Cansler discloses generating a web page that has a display

control program and data needed (col. 4, ll. 5-13). Cansler teaches the computations are

performed by the receiving terminal (col. 4, line 17). Cansler teaches transmitting the through a

network (col. 5, ll. 7-25).

Cansler does not disclose optimization. Uemura discloses optimizing a web page according to

load on the server (col. 2, ll. 9-13 and col. 5, ll. 21-23). It would have been obvious to one of

ordinary skill in the art at the time of the invention to optimize Cansler with the teachings of

Uemura in order to statisfy users (Uemura, col. 1, ll. 59-61) and prevent them from leaving the

site (Uemura, col. 11, ll. 30-37).

Regarding independent claim(s) 9, Cansler discloses generating a web page that has a display

control program and data needed (col. 4, ll. 5-13). Cansler discloses selecting the program

according to a request (col. 4, ll. 33-36). Cansler teaches the computations are performed by the

receiving terminal (col. 4, line 17). Cansler teaches transmitting the through a network (col. 5, ll.

7-25).

Cansler does not disclose optimization. Uemura discloses optimizing a web page

according to capability of the receiving terminal (col. 2, ll. 9-13). It would have been obvious to

one of ordinary skill in the art at the time of the invention to optimize Cansler with the teachings

of Uemura in order to statisfy users (Uemura, col. 1, ll. 59-61) and prevent them from leaving the

site (Uemura, col. 11, ll. 30-37).

Regarding independent claim(s) 10, Cansler discloses generating a web page that has a display

control program and data needed (col. 4, ll. 5-13). Cansler discloses selecting the program

according to a request (col. 4, ll. 33-36). Cansler teaches the computations are performed by the

receiving terminal (col. 4, line 17). Cansler teaches transmitting the through a network (col. 5, ll.

7-25).

Cansler does not disclose optimization. Uemura discloses optimizing a web page according to capability of the receiving terminal (col. 2, ll. 9-13), including display format (col. 3, ll. 35-50). . It would have been obvious to one of ordinary skill in the art at the time of the invention to optimize Cansler with the teachings of Uemura in order to statisfy users (Uemura, col. 1, ll. 59-61) and prevent them from leaving the site (Uemura, col. 11, ll. 30-37).

Regarding independent claim(s) 11, Cansler discloses generating a web page that has a display control program and data needed (col. 4, ll. 5-13). Cansler discloses selecting the program according to a request (col. 4, ll. 33-36). Cansler teaches the computations are performed by the receiving terminal (col. 4, line 17). Cansler teaches transmitting the through a network (col. 5, ll. 7-25).

Cansler does not disclose optimization. Uemura discloses optimizing a web page according amount of network traffic (col. 2, ll. 9-13). It would have been obvious to one of ordinary skill in the art at the time of the invention to optimize Cansler with the teachings of Uemura in order to statisfy users (Uemura, col. 1, ll. 59-61) and prevent them from leaving the site (Uemura, col. 11, ll. 30-37).

Regarding independent claim(s) 12, Cansler discloses generating a web page that has a display control program and data needed (col. 4, ll. 5-13). Cansler discloses selecting the program according to a request (col. 4, ll. 33-36). Cansler teaches the computations are performed by the receiving terminal (col. 4, line 17). Cansler teaches transmitting the through a network (col. 5, ll. 7-25).

Cansler does not disclose optimization. Uemura discloses optimizing a web page according to capability of the network (col. 2, ll. 9-13 and col. 4, ll. 43-45). It would have been

obvious to one of ordinary skill in the art at the time of the invention to optimize Cansler with

the teachings of Uemura in order to statisfy users (Uemura, col. 1, ll. 59-61) and prevent them

from leaving the site (Uemura, col. 11, ll. 30-37).

Regarding independent claim(s) 13, Cansler discloses generating a web page that has a display

control program and data needed (col. 4, ll. 5-13). Cansler discloses selecting the program

according to a request (col. 4, ll. 33-36). Cansler teaches the computations are performed by the

receiving terminal (col. 4, line 17). Cansler teaches transmitting the through a network (col. 5, ll.

7-25).

Cansler does not disclose optimization. Uemura discloses optimizing a web page

according to load on the server (col. 2, ll. 9-13 and col. 5, ll. 21-23). It would have been obvious

to one of ordinary skill in the art at the time of the invention to optimize Cansler with the

teachings of Uemura in order to statisfy users (Uemura, col. 1, ll. 59-61) and prevent them from

leaving the site (Uemura, col. 11, ll. 30-37).

Regarding independent claim(s) 14-15, Cansler discloses generating a web page that has a

display control program and data needed (col. 4, ll. 5-13). Cansler discloses selecting the

program according to a pre-determined condition (col. 4, ll. 13-16). Cansler teaches the

computations are performed by the receiving terminal (col. 4, line 17). Cansler teaches

transmitting the through a network (col. 5, ll. 7-25).

Cansler does not disclose optimization. Uemura discloses optimizing a web page

according to capability of the network (col. 2, ll. 9-13 and col. 4, ll. 43-45). It would have been

obvious to one of ordinary skill in the art at the time of the invention to optimize Cansler with

the teachings of Uemura in order to statisfy users (Uemura, col. 1, ll. 59-61) and prevent them from leaving the site (Uemura, col. 11, ll. 30-37).

Response to Arguments

11.   Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

        Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

**SANJIV SHAH
PRIMARY EXAMINER**